



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06742666	12/17/86	LIN	FILE 204 R3

SPRUNG HORN KRAMER & WOODS
600 THIRD AVENUE
NEW YORK, NY 10016

EXAMINER	
TODD	
ART UNIT	PAPER NUMBER
183	15

DATE MAILED: 07/15/88

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on May 4, 1988 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-848. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-7 and 11 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-7 and 11 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

06/942,666

The text of those sections of Title 35 U. S. Code not included in this action can be found in a prior Office action.

Claims 1-7 and 11 are in the case.

Claims 1-7 and 11 are rejected under 35 U.S.C. 112, first paragraph, as the disclosure is enabling only for claims limited in accordance with the specific examples. See MPEP 706.03(n) and 706.03(z).

The term "warm blooded animals" remains rejected for the same reason as stated in the previous office actions, see paper no. 8 and no. 13. The term "human blood cells" as amended is still rejected in that it broadly encompasses living cells inside a human body.

Applicant's arguments filed May 4, 1988 have been fully considered but they are not deemed to be persuasive.

The specification is seen only enabling for "in vitro blood cells." The US Patent 4,710,492 regarding 5-halo-3'-azido-2',3'-dideoxyuridine and Yarchoan et al regarding clinical trial of DDC have been noted, however, they are not convincing insofar as the above rejection relates to the claimed hosts since the core structures of the nucleosides in above articles are not similar to the instant nucleoside for proper comparison. The specification is enabling for what it shows. At present, in vitro tests on AIDS virus has not been

accepted as being predictive of efficacy in treating humans. In the absence of proper correlation between the instant in vitro data and utilization and usefulness in humans, there lacks an adequate disclosure for the claimed hosts.

The rejection to claims 1-7 and 11 under 35 USC 103 over the art of record has been hereby withdrawn from consideration in view of declaration of Dr. William H. Prusuff under Rule 132 that the closest prior art 5-ethyl compound has no antiviral activity against HIV-1 (the AIDS virus) in vitro, and therefore, the use of the instant 5-methyl compound is not obvious therefrom.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See MPEP 706.07(a).

Applicant is reminded of the extension of time policy set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

The references supplied with applicants' response are listed in PTO 892. When submitting references,

Serial No. 942666

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Art Unit 183

applicants should enclose a disclosure statement listing each reference supplied.

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 183.

Any inquiry concerning this communication should be directed to Tou at telephone number 703-557-7624.

JT

Tou:meb

7/13/88

Ronald W. Griffin

RONALD W. GRIFFIN
PRIMARY EXAMINER
ART UNIT 183